

REMARKS

Claims 1, 10, 13, 29, and 36-46 are pending in the case, claims 2-9, 11-12, 14-28, and 30-35 having previously been canceled and claims 36-46 having previously been added. The Office Action rejected the claims as follows:

- claims 1, 10, 13, 36 and 42-46 under 35 U.S.C. §112, ¶1 as including new matter;
- claims 1, 13, 29-30, and 38-39 as anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 6,944,474 (“Rader, *et al.*”);
- claims 29-30, 38-39 and 42-45 as anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 7,110,951 (“Lemelson, *et al.*”);
- claims 1, 10, 13, and 36-37 as obvious under 35 U.S.C. §103(a) over Lemelson *et al.*;
- claims 31 and 40 as obvious under 35 U.S.C. §103(a) over Lemelson *et al.* in view of U.S. Letters Patent 3,808,354 (“Feezor”);
- claim 41 as obvious under 35 U.S.C. §103(a) over Lemelson *et al.* in view of Feezor and in further view of U.S. Patent 5,550,923 (“Horvet”); and
- claim 46 as obvious under 35 U.S.C. §103(a) over Lemelson *et al.* in view of Rader.

Applicants continue to traverse each of the rejections in this case.

Applicants hereby incorporate their arguments set forth in the response to the Office Action dated July 31, 2007, in response to the rejections set forth in the current Office Action. Applicants address herein only the new grounds of rejection for new matter and the Office’s remarks on those previous arguments. The amendments to the claims set forth above are related to the new matter rejection and will be discussed at that point.

I. THERE IS NO NEW MATTER, AND THE AMENDMENTS SHOULD BE ENTERED

Applicants do not concede that any of the amendments previously presented introduce new matter. However, Applicants nevertheless seek to amend the claims to ameliorate the Office’s concern. The issue is now moot in light of the amendments to the claims.

II. ART REJECTIONS

A. CLAIMS 1, 13, 29-30, AND 38-39 ARE NOVEL OVER RADER, ET AL.

1. **Rader et al. Still Fails to Teach User Authentication as Recited in Claims 1, 13, and 38-39**

In rebutting the Office's rejection of claims 1 and 13 as anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 6,944,474 ("Rader, *et al.*"), Applicants pointed out that Rader, et al. fails to teach user authentication. Claims 38-39 now recite and incorporate, respectively, this limitation. The Office takes issue with this argument. However, the Office's position is riddled with error and hindsight.

More particularly, the Office latches onto the disclosure of a "PIN" in Rader *et al.* as disclosure of user authentication. As Applicants previously noted, a "PIN" is used for identification, as the term "Personal *Identification* Number" from which the acronym is derived clearly implies. A PIN may, or may not, be used for authentication.

The Office first attempts to leverage the meaning of the word "personal" to erase the implications of the term "identification", and argue essentially that a PIN *must* mean authentication:

The keyword here is "personal". Once skilled in the art, after reading Rader, would have expected that the personal data should be accessed only by the user or other authorized personnel at a doctor's office.

"Detailed Action", p. 7, ¶10. Thus, the Office is—in hindsight—imputing a connotation of "confidential" on the meaning of "personal". This is not necessarily the case. Note that the Office cannot find one passage in Rader, et al. to support this position. Not all personal information is confidential. For example, one's marital status and whether one has impaired vision requiring corrective lenses to drive are both pieces of personal information. However, both are also readily ascertainable from public records. The Office's imputation is not warranted on the evidence of record and can only have arisen in hindsight.

The Office then posits that a PIN *must* be authenticated:

The user has to enter a PIN, so the system can transfer the correct data over to the mobile phone. The word “authenticate”, by Webster’s Ninth New Collegiate Dictionary, means to confirm. The PIN disclosed in Rader has to be confirmed by the remote site to approve the request of transferring hearing [sic] profile. For example, if the user enter [sic] an incorrect PIN, would the remote site transfer someone else [sic] data? or [sic] if not data at all?

“Detailed Action”, p. 7, ¶10. Again, note that the Office has failed to cite even one passage from Rader, et al. in support of this position. But the supposition is also wrong. Why must the remote site confirm the PIN before transferring the profile? This certainly may not be true in some circumstances. In answer to the Office’s rhetorical questions, yes—on the face of Rader, et al., it would transfer the wrong profile. In some circumstances, this might not be the problem that the Office supposes it to be.

The Office then links its improperly imputed connotation of “confidentiality” on the information to be transferred and links it to the PIN:

One skilled in the art would have expected that the PIN as disclosed in Rader as a safeguard to prevent the information leaking to other non-authorized person [sic].

“Detailed Action”, p. 7, ¶10. As was established above, there is nothing in the evidence of record to justify the unwarranted presumption that the information to be transferred is confidential.

The Office then makes the completely unsupported and just plain wrong observation that PIN is the best form of identification:

If following applicant’s [sic] argument that PIN [sic] is only for identification purpose [sic], such as those provided by soldiers, the name of the user should be the best identification. Everyone will remember his/her own name, so [sic] will his/her acquaintance. A user might forget his/her PIN, but most likely will not forget his/her own name.

“Detailed Action”, p. 7, ¶10. The Office simply ignores the examples provided by Applicants—namely, serial numbers for members of the Armed Forces and for prison populations—to offer this specious argument. Here is one more indisputable, undeniable example—the Internal Revenue Service of the United States federal government tracks taxpayer filings *by a personal identification number, such as a social security number or a taxpayer ID, rather than by taxpayer name.*

This idea can be refuted by another quick example. The property tax records for Harris County, Texas are available online in a searchable format at <http://www.tax.co.harris.tx.us/propertytax/current/currentsearch.asp>. On January 21, 2008, the undersigned ran a search for current property taxes owed by a taxpayer named “Stephen Smith”. The search turned up 49 records, a true and correct copy of which is filed herewith as Exhibit A. Note that the search results even include six Stephen W. Smiths, five Stephen J. Smiths, five Stephen A. Smiths, and four Stephen R. Smiths. Clearly, one’s name might not be the “best” identifier in some contexts.

Note also that each entry includes and is indexed by a unique identification number rather than the taxpayer name. This would seem to put the seal on the Office’s error. Indeed, Applicants posit that one reason why systems operating off names as identifiers also employ PINs is not so much for protection of confidentiality as because names are insufficient. As Exhibit A establishes, many people can have the same name, but only one can have a unique PIN.

The Office then conflates all these errors in a grand finale:

The purpose of having PIN is to prevent anyone else besides the user to have the access to the hearing profile. A PIN is usually only given to the user. The PIN confirms that it is the user who wants to data [sic]. Therefore Rader discloses the claimed invention.

“Detailed Action”, pp. 7-8, ¶10. The first statement is manifestly incorrect. For example, as established in Exhibit A, a numerical identifier is not assigned for security reasons but to keep straight which account belongs to which taxpayer having the same name. The second sentence is merely a truism that does nothing to advance the Office’s position. The third statement is contrary to the disclosure of Rader, et al. In Rader, et al., the PIN identifies the user rather than authenticating the identification.

Returning to the legal standards, an anticipation must arise from the four corners of the reference. Of all the error-riddled arguments set forth by the Office, *not one of them comes from the text of Rader, et al.* Even foregoing all the errors, the Office cannot resort to them because they are outside the four corners of the reference. Thus, Rader *et al.* fails to disclose user authentication as recited or incorporated in each of claims 1, 13, and 38-39. Rader *et al.*

therefore fails to anticipate any of these claims. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

**2. Rader et al. Fails to Teach Detection as is Recited
in Claims 29-30 and 38-39**

The Office also disputes that its construction of “detect” is technically and technologically incorrect with respect to the rejections of claims 29-30 and 38-39. More particularly, Applicants argued:

Applicants respectfully submit that a user does not “detect” the test signal, but rather “hears” the test signal. To equate “hearing” and “detecting” in this context is technically and technologically wrong. Furthermore, the “user’s response” is not indicative of the detected acoustic test signal”. It is instead indicative of the fact that the user heard the test signal—it provides no information regarding the test signal itself.

Response to Office Action, p. 11. While the Office’s response does not actually rebut this argument, it also ignores the fact that claims 29-30 recites a “computer program product.” Inanimate objects do not “hear.” Furthermore, there is no reason to construe the term differently in claims 38-39 than in claims 29-30. The Office’s position expressly admits that it is the user that “hears” the acoustic signal, and not a computing apparatus executing a program. The Office therefore is apparently confusing an apparatus for a person.

Rader *et al.*, when *properly* construed, therefore does not teach detection as is recited or incorporated in each of claims 29-30 and 38-39. Rader *et al.* therefore fails to anticipate any of these claims because it fails to teach all the limitations thereof. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

**B. CLAIMS 29-30, 38-39 AND 42-45 ARE NOVEL
OVER LEMELSON, *ET AL.***

The Office Action rejected claims 29-30, 38-39 and 42-45 as anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 7,110,951 (“Lemelson, *et al.*”). As with Rader *et al.*, each of the independent claims recites a limitation not taught or suggested by Lemelson *et al.* More particularly, each independent claim 29, 38, and 42 recites “receiving data indicative of a detected acoustic test signal” and “a device profile”.

Lemelson *et al.* teaches nothing regarding “detection” for the same reasons that Rader *et al.* does not—namely, because they are different things. Claims 29-30 recites a “computer program product.” Inanimate objects do not “hear.” Furthermore, there is no reason to construe the term differently in claims 38-39 or 42-45 than in claims 29-30. The Office’s position expressly admits that it is the user that “hears” the acoustic signal, and not a computing apparatus executing a program. The Office therefore is apparently confusing an apparatus for a person.

Applicants also previously pointed out that Lemelson *et al.* fails to teach a device profile such as is recited in claim 42 and other claims. The Office responded:

On p. 11, applicant [*sic*] argued that Lemelson fails to show a device profile. This is not persuasive. First of all, the amended claim 42 introduced new matter and is being rejected under 112, 1st paragraph above. Secondly claim 42 states that “receiving data associated with an audio profile and a device profile” [*sic*] Both applicant [*sic*] and examiner [*sic*] agreed that elements 28, 30 and 32 are part of device [*sic*] profile, so any data from any of 28, 30, and 32 reads on the data associated with a profile device.

“Detailed Action”, p. 8, ¶10. First of all, the new matter rejection is not relevant to the present dispute and is now moot. Second of all, as Applicant earlier pointed out:

While these modules 28, 30, and 32 might be part of a device profile, they do not themselves provide data regarding a device profile. They instead provide data that can be displayed to a hearing impaired user (col. 11, lines 26-36) and to correct errors produced by the speech recognition and lip reading modules (col. 11, lines 37-51), respectively.

Response to Office Action, p. 11. The Office’s construction is therefore repudiated on the face of the reference— Lemelson *et al.* establishes quite to the contrary of what the Office asserts.

Lemelson *et al.*, when *properly* construed, therefore does not teach detection or a device profile as is recited or incorporated in each of claims 29-30, 38-39 and 42-45. Lemelson *et al.* therefore fails to anticipate any of these claims because it fails to teach all the limitations thereof. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

C. ALL OF THE REMAINING CLAIMS ARE ALLOWABLE OVER THE ART OF RECORD

The “final” Office Action iterated a number of obviousness rejections, including:

- claims 1, 10, 13, and 36-37 as obvious under 35 U.S.C. §103(a) over Lemelson *et al.*;
- claims 31 and 40 as obvious under 35 U.S.C. §103(a) over Lemelson *et al.* in view of U.S. Letters Patent 3,808,354 (“Feezor”);
- claim 41 as obvious under 35 U.S.C. §103(a) over Lemelson *et al.* in view of Feezor and in further view of U.S. Patent 5,550,923 (“Horvet”); and
- claim 46 as obvious under 35 U.S.C. §103(a) over Lemelson *et al.* in view of Rader.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 706.02(j); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

As was established above, Lemelson *et al.* fails to anticipate any claim. The only exceptions are claims 1 and 10, which Lemelson *et al.* fails to anticipate because they recite “a device profile” as was established above. Each of the obviousness rejections relies on Lemelson *et al.* to teach or suggest all the limitations independent claims. Since Lemelson *et al.* fails to do so, and since the secondary references do not remedy this deficiency, the art of record fails to teach or suggest all the limitations of the claims. Accordingly, none of claims are obvious over the art of record. M.P.E.P. § 706.02(j); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

III. CONCLUDING REMARKS

Applicants therefore once more respectfully submit that the rejection is improvident and request that it be withdrawn. Accordingly, Applicants request that the rejections be withdrawn and the claims be allowed to issue. The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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WILLIAMS, MORGAN & AMERSON
10333 Richmond Dr., Suite 1100
Houston, Texas 77042
(713) 934-4053 ph

/Jeffrey A. Pyle/
Jeffrey A. Pyle
Reg. No. 34,904
Attorney for Applicants